

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Appellant : James Thomas Edward  
McDonnell, et al

## Reply Brief

Patent Application No.: 09/816,683

Group Art Unit: 2135

Filed: 03/23/2001

Examiner: Dada, Beemnet W

For: “Providing Location Data...”

Date: January 31, 2007

## REPLY BRIEF

Mail Stop Reply Brief  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This paper is a Reply Brief to the Examiner's Answer issued on December 1, 2006 for the above-referenced patent application. Please enter the following remarks into the prosecution history of the above-mentioned application. **All remarks herein are made without prejudice.**

## REMARKS

The comments in the Appeal Brief filed on September 6, 2006 are incorporated herein by reference.

**Issue 1: Whether Claims 1-5, 7-12, 14, 16-18, 24-28 and 30-31 are patentable under 35 U.S.C. 102(e) in view of Pirila, U.S. Patent No. 6,674,860, (hereinafter "Pirila")?**

**Claim 1**

Appellants submit that Pirila does not disclose, suggest or teach, *inter alia*, at least the following features recited by Claim 1 of the present application:

"location data is provided in encrypted form by a location server to a recipient" (emphasis added)

The Examiner asserts that the "location data" as recited in Claim 1 is disclosed by Pirila's "location information." See page 2, section 4 of the Official Action.

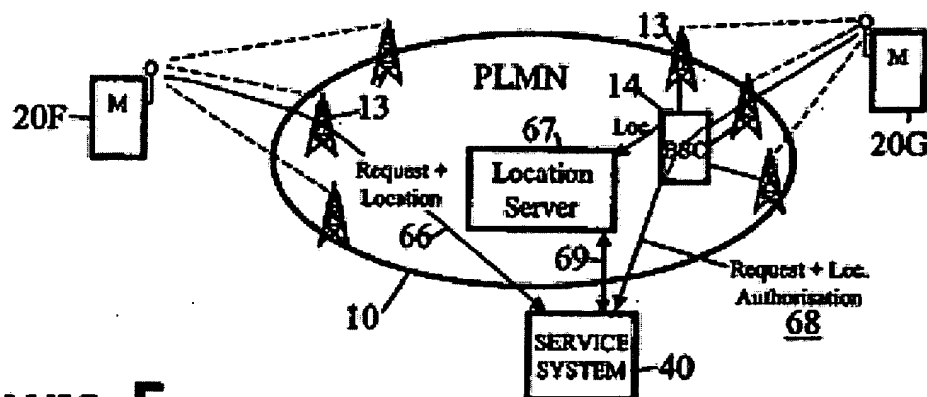
Although Pirila is concerned with the transfer of encrypted "location information" to a mobile station, the term "location information" as used in Pirila means:

"base station position coordinates, real time difference (RTD) data and other base station related data that are needed to determine the location of a mobile station"

as is explained at column 3, lines 53-56 of Pirila. It is fundamental to the whole concept of Pirila that the location information is information related to the base stations and that this location information is encrypted and broadcast to mobile entities. In contrast to Pirila, the "location data," as recited claim 1, "represents the **location of the mobile entity**" (emphasis added).

In responding to Appellants' arguments, the Examiner asserts that Appellants' specification supports the Examiner's position that Pirila anticipates Claim 1 (p. 6, ll. 3-17 of Examiner's answer). Specifically, the Examiner relies on page 9, lines 14-18 and page 7, lines 22-32 of the Appellants' specification as allegedly disclosing that Pirila's location information "represents location of the mobile entity" as recited in Claim 1 rather than representing information related to the base stations. Appellants strongly disagree.

Appellants submit that the portions of the specification relied upon by the Examiner refer to and describe prior art shown in Figure 5, reproduced below.



**Figure 5**  
(Prior Art)

According to the Examiner, the prior art shown in Figure 5 and the related text determine the location of a mobile entity by observing time difference measurements with respect to signals received from base stations 13 (p. 6, ll. 9-11). The Examiner further concedes that Pirila also teaches determining location of the mobile station on the basis of timing differences between signals received from at least two base stations (p. 6, ll. 13-14).

The Examiner thus relies on two prior art references, that of Figure 5 and Pirila, that both disclose determining the location of a mobile station using timing difference measurements. Furthermore, Pirila clearly defines “location information” that is transmitted to the mobile stations as being information related to the base stations. Nonetheless, the Examiner conveniently interprets that Pirila’s location information “represents location of the mobile entity” as recited in Claim 1, instead of representing information related to the base stations as clearly recited by Pirila. How is that possible? How can prior art shown in Figure 5 be relied upon to modify the definition of Pirila’s location information when prior art shown in Figure 5 and Pirila both use timing difference measurements? The Examiner’s assertions clearly contradict the teachings of Pirila and are therefore incorrect.

Appelants further note that modifying Pirila to define location information as representing “location of the mobile entity” as alleged by the Examiner would in fact render Pirila’s invention unsatisfactory for its intended purpose.

According to MPEP §2143.01, if “proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).”

As shown above, Pirila clearly defines location information as representing information related to the base stations. By replacing the information related to the base stations with the location of the mobile entity, one skilled in the art would render Pirila unsatisfactory for its intended purpose because Pirila’s mobile station does not foresee receiving anything but the information related to the base station.

Therefore, Appellants submit that Pirila does not teach, disclose or suggest “location data is provided in encrypted form by a location server to a recipient” wherein the

“location data ... represents the location of a mobile entity” as recited in Claim 1, because Pirila defines location information as being information about the base stations and prior art Figure 5 does not contradict this definition. Hence, Claim 1 is patentable over Pirila and the rejection of this claim should be reversed on appeal.

#### Claims 2-18

Claims 2-18, at least based on their dependency on Claim 1, are also patentable over Pirila and the rejection should be reversed on appeal.

#### Claim 24

Appellants submit that, at least for the reasons stated above for Claim 1, Pirila does not teach, disclose or suggest “location data that represents the location of a mobile entity ... a location server for providing said location data in encrypted form” as recited in amended Claim 24. Hence, Claim 24 is patentable over Pirila and the rejection should be reversed on appeal.

#### Claims 25-30

Claims 25-30, at least based on their dependency on Claim 24, are also patentable over Pirila and the rejection should be reversed on appeal.

#### Claim 31

Appellants submit that, at least for the reasons stated above for Claim 1, Pirila does not teach, disclose or suggest “location data that represents the location of a mobile entity ... the location data is provided in encrypted form by a location server to the mobile entity” as recited in Claim 31. Hence, Claim 31 is patentable over Pirila and the rejection should be reversed on appeal.

### Conclusion

For the extensive reasons advanced above, Appellant respectfully contends that each claim is patentable. Therefore, reversal of all rejections and objections is courteously solicited.

The Commissioner is authorized to charge any additional fees which may be required or credit overpayment to deposit account no. 08-2025. In particular, if this Appeal Brief is not timely filed, the Commissioner is authorized to treat this response as including a petition to extend the time period pursuant to 37 CFR 1.136(a) requesting an extension of time of the number of months necessary to make this response timely filed and the petition fee due in connection therewith may be charged to deposit account no. 08-2025.

I hereby certify that this correspondence is being deposited with the United States Post Office with sufficient postage as express mail in an envelope addressed to: Mail Stop Reply Brief - Patents, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22323-1450 on

January 31, 2007

(Date of Mailing)

Trisha Lozano

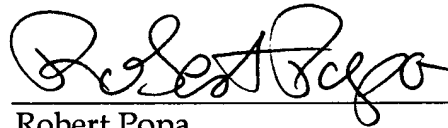
(Name of Person Mailing)

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January 31, 2007

(Date)

Respectfully submitted,



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